Subject Index.

	Page
The patents in suit have never previously been litigated	2
History of the case	2
Statement	3
Re petitioner's four "questions presented"	9
The reasons relied upon for allowance of the writ	9
Re petitioner's brief	11
Conclusion	11
Appendix A	13
Brief history of the Kamborian invention	13
Appendix B	16
Cases in other circuits	16

Table of Authorities Cited.

Cases.

Beidler v. United States, 253 U.S. 447	7
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405	11
Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428	7
Eames v. Andrews, 122 U.S. 40	7
Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275 (60 U.S.P.Q. 386)	12
Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1	8, 9
Keller v. Adams-Campbell Co., Inc., 264 U.S. 314	11
La Bourgogne, 210 U.S. 95	11
Layne & Bowler Corp. v. Western Well Works, Inc., 261 U.S. 387	11
Morely Sewing Machine Co. v. Lancaster, 129 U.S. 263	9

	Page
Remington Cash Register Co. v. National Cash Register Co., 6 F. (2d) 585	4
Smith v. Snow, 294 U.S. 1	8
Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U.S. 471	11
Westinghouse v. Boyden Power Brake Co., 170 U.S. 537	10
White v. Bruce Co., 152 F. (2d) 304	7
STATUTES.	
Revised Statutes, sec. 4888	3, 4, 7
Rules of Supreme Court, Rule 38, sec. 5 (b)	1, 10

Supreme Court of the United States.

OCTOBER TERM, 1948.

No. 343.

UNITED SHOE MACHINERY CORPORATION,
Petitioner,
v.
JACOB SIMON KAMBORIAN
AND
INTERNATIONAL SHOE MACHINE CORPORATION,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Respondents are here confronted with a petition in which fact is inextricably mingled with argument and with repeated reference to petitioner's contentions advanced below but which were rejected by the trial and the appellate courts.

The petition and brief in support thereof do not show that this case comes within the provisions of Section 5 (b) of Rule 38 of this Court.

The Patents in Suit have Never Previously been Litigated.

This case does not present a question upon which varying views have been expressed by different Circuit Courts of Appeals; nor a situation in which a Circuit Court of Appeals has decided an important question of Federal law which has not been but should be settled by this Court; nor has the Circuit Court of Appeals decided a Federal question in a way probably in conflict with applicable decisions of this Court; nor is this a case in which further litigation in other Circuits would be at all unlikely.

There is no question of unusual public importance here raised *which has not heretofore been decided** by this Court. Instead this is an ordinary patent case involving the usual questions of infringement and validity, and concerns only the parties involved.

History of the Case.

The subject matter of the controversy involves the lasting of shoes. Petitioner is the United Shoe Machinery Corporation, which for almost fifty years has been supplying a general line of shoe machinery, including lasting machines, to the shoe factories. Respondents are the inventor Kamborian and his Company, the licensee under the patents here in suit. The only important products of the respondent Company are the lasting machines of the patents in issue. The invention is of *pioneer character* (R.I. p. 14, par. 3).† (For a further history of the invention see Appendix A.)

---

*Emphasis ours throughout.

†We refer herein to the Transcript of the Record in the first appeal as R.I., and to the additional Transcript of the Record in the second appeal as R. II.

This case has been *unusually* well tried and reviewed. Petitioner has had adequate opportunity to persuade the lower courts to accept and approve its views of this case. At two successive trials the District Judge had opportunity to study the patents in the light of the evidence and to observe the operation of the patentee's machine embodying the invention. The Circuit Court of Appeals twice reviewed the findings of the District Court.

The two reviewing opinions below were rendered by the same Circuit Court of Appeals. The same judge wrote the successive opinions. It is true that one judge was replaced by another at the second hearing, but there was no dissent. In fact, petitioner had the benefit of consideration by *four* judges rather than the usual three. In both opinions the Circuit Court of Appeals concurred with the District Court in the finding of infringement, and in its second opinion unqualifiedly affirmed the District Court's findings that the patents are valid.

Statement.

Petitioner (almost completely disregarding the presence of two method claims in the case) now seeks a further review of the case on the ground that the claims do not meet the requirements of Rev. Stat. § 4888.

Obviously criticisms of the machine claims, as not complying with those provisions of Section 4888 of the Revised Statutes, which concern a *machine* only, do not apply to the method claims. Thus, even if petitioner's contentions were to be sustained as to the machine claims, petitioner would still infringe valid claims, as held by the courts below.

The patented machine is widely and successfully used for its intended purpose. Petitioner has accorded to the

patented machine the compliment of infringing imitation. Petitioner's attack on validity for failure to comply with Section 4888, Rev. Stat., was *originally* aimed at a supposed failure of the patent to describe an operative machine.

The burden of proving inoperativeness in a patent case is heavily on the defendant (*Remington Cash Register Co.* v. *National Cash Register Co.*, 6 F. (2d) 585), but in this instance the defendant never attempted to demonstrate inoperativeness of the machine itself, and confined itself largely to theoretical argument, leaving it to respondents to show positively, which they did (R. II, p. 109, beginning at line 8), that the patented machine does work when constructed and operated as described in the patent (R. II, p. 39, line 29 *et seq.;* p. 43, line 16; pp. 53-55).

The admitted operativeness of the Kamborian commercial machine compelled petitioner to take refuge in the fact that, in the commercial machine then in use, a certain work guide (illustrated and described in the patent) was omitted. On this basis, at the first hearing before the Circuit Court of Appeals, petitioner plausibly (but not convincingly) argued, without evidential support, that the omission ("jettisoning") of this guide accounted for the operativeness of the commercial machine, and deduced therefrom that the commercial machine operated according to a theory or principle different from that set forth in the patent.*

The utter fallacy of petitioner's argument was proved by respondents, who demonstrated in the presence of the

*Specifically, petitioner *urged* that with the work guide in place, as shown in the patent, the machine was inoperative, but that in the operative, commercial machine (in which the work guide was omitted) the stressing force necessary for lasting could be and was supplied by the operator himself.

District Judge and to his complete satisfaction (R. II, p. 19) that no such supposedly new theory or principle was involved, and that the machine does operate satisfactorily to last shoes *when equipped with the work guide* of the patent.

No serious question was raised below as to the sufficiency of the patent to tell the world *how to build* the machine. In its first opinion the Circuit Court of Appeals remarked:

> "The detailed description given in the Kamborian application is no amateur's job. The machinery is described in detail with drawings which were done with professional accuracy" (R. II, pp. 25, 26).

The instructions found in the patent for *operating* the machine are ample, when followed, to accomplish the intended result (R. II, p. 109).

That which establishes the Kamborian machine as a pioneer in the lasting machine field and which distinguishes it from all of petitioner's prior machines (R. pp. 152, 153; XQs. 553, 554) and from all that went before it in the lasting art (R. I, p. 14), is the *uninterrupted* advance of the work (such as results from the employment of a constantly rotating feed roll) by means which positively grips the work, while the lasting stress is being applied, and which simultaneously delivers the work into the field of action of a wiper device competent to wipe the material in as fast as it escapes from the gripping means.

Petitioner urges (though it did not plead it) that the patent fails to tell *"how the machine works."*

How the machine operates in accomplishing the new mode of lasting is clearly pointed out by the patentee, who says:

> "Thus the rolls not only exert upward pull but also tend to move the material of the upper in a direction substantially parallel to the edge of the insole, in other words to *exert a feeding action* upon the work tending to move the last and the upper in a direction longitudinal of the last. . . . As the *gripper* rolls *feed the work* along they stretch it and then release it and as it is released it is engaged by the *rapidly vibrating* wiper 44 and is wiped in smoothly over the bottom of the insole" (Patent No. 2,251,284 [R. I, p. 189], p. 3, col. 2, of the patent specification, beginning at line 15).

The Circuit Court of Appeals in its first opinion, observing that the "statute requires that the inventor describe *how his machine works*" (R. II, p. 27), remanded the case in order that the District Judge might "give explicit findings" (R. II, p. 29) as to whether the Kamborian machine works as described.

In its second opinion the Circuit Court of Appeals said (R. II, p. 107):

> "We sent the case back for further consideration for we were not clear whether the machine operated the way the inventor said it did. . . . We posed several questions which we thought brought the issue into focus."

The opinion then notes that to each of these questions the District Court "gave an affirmative reply" (R. II, p. 108), and continues (R. II, p. 109):

> "An examination of the record reveals evidence to support the fact conclusions reached in answer to the questions we asked upon remand.

"The question involved is purely factual and Rule 52 is applicable. Kamborian is bound to show *how his machine works* but not why. *He satisfied his burden* when he showed the procedure whereby a shoe, not lasted when the journey through the machine began, comes out lasted in a manner described as 'satisfactory' to 'very good' *in accordance with the directions in his* patent"; citing *White* v. *Bruce Co.*, 152 F. (2d) 304; *Eames* v. *Andrews*, 122 U.S. 40; and *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 435-436.

The Circuit Court of Appeals thus recognized and followed the interpretation of Rev. Stat. § 4888, as established by this Court. No contrary nor qualifying decisions of any court have been cited upon this point by petitioner. *Beidler* v. *United States*, 253 U.S. 447, 453, follows the above-cited decisions of this Court. (That a proposal has been made to *amend* this section of the statute [as stated by petitioner's counsel] is no indication that further judicial comment is required at this time.)

As noted by the Circuit Court of Appeals, the matter is purely factual. It was decided only after careful consideration in the light of answers to mandated questions directed to this particular point; the District Judge heard further testimony and answered these questions; the Circuit Court of Appeals examined the record; found the evidence to support the fact conclusions; and held that Kamborian had satisfied his burden of showing how his machine works.

It is submitted that respondents should not be compelled to relitigate this matter.

With reference to the sufficiency of the two machine *claims* here in issue, the Circuit Court of Appeals in its second opinion observed (R. II, p. 110):

> "We think these claims when read with the specifications state the *physical combination* of the various mechanical elements and *their functional interrelationship and operation* in a manner sufficient to describe the function of the wiper. Claim 28 points out that the wiper engages a portion of the leather while 'stress (by the gripping means) is being concomitantly applied' to another area of the leather. If the foregoing language is ambiguous or not definite enough, the meaning is made clear in the explanatory specifications."

Thus the Circuit Court of Appeals specifically rules that the claims 26 and 28 here in issue are sufficient, definite and non-ambiguous. In explaining the use of a pair of gripper rolls and rapidly reciprocating wiper as a means for accomplishing the desired result, Kamborian disclosed the best mode known to him at that time for applying the principle of the invention. As this Court remarked in *Smith* v. *Snow,* 294 U.S. 1, 11:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. . . . it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced in practice."

Respondents do not conceive that the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1, categorically disapproves patent claims in which one or more elements are recited as means for doing this or that; in particular where, as here, the invention is of

pioneer character. Nor do they conceive, indeed, that the doctrine expressed in the Halliburton decision is a novel one, as the Court itself seems to say on page 11 of the report. However, it may be observed that claims 26 and 28 here in issue are precisely in the form of the claim approved by this Court in *Morely Sewing Machine Co.* v. *Lancaster,* 129 U.S. 263, 266, 268, where, as here, a pioneer invention was involved.

Re Petitioner's Four "Questions Presented."

These questions are purely hypothetical. They do not appear to be predicated upon the facts as found and accepted by the courts below, but upon petitioner's version of the facts as it would like them to be or upon its own biased views as to what the Circuit Court of Appeals decided.

To answer these questions in the form in which they are propounded would necessitate trial *de novo.*

The Reasons Relied upon for Allowance of the Writ.

Paragraph 1, sections *a* to *d,* are substantial repetitions of the "Questions Presented," but in declaratory form.

They find no basis in the opinion below, but rest upon the bland assumption by petitioner that it is correct as to the facts and that the Circuit Court of Appeals is wrong.

The opinion of the Circuit Court of Appeals fully and clearly answers and refutes petitioner's assertions as to alleged errors in the patent in suit. No reason is advanced which finds a basis in the opinion of the Circuit Court of Appeals, as actually rendered, and no proper reason has been advanced necessitating re-examination by this Court.

Paragraph 2*a*: The Circuit Court of Appeals has not found and has not decided in this case that a claim to a combination of *two* means, coacting to perform a designated function, is infringed by a machine in which said function is performed by a single means. The machine of the patent and the accused machine were found to have *corresponding* elements (Judge Sweeney's first opinion, R. I, p. 16, last paragraph). *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537, seems to have no application.

Paragraph 2*b*: No question as to the form of the claims in issue was ever raised below. The decisions cited by petitioner do not appear to be applicable here.

Paragraph 3: No evidence has been adduced to suggest that future litigation before Circuit Courts of Appeals for other Circuits is unlikely, as respects the patents here in issue, or to show that the decisions cited by petitioner are applicable to the present case. If petitioner's counsel count on judicial notice in support of this ground, respondents may be permitted to state that shoe machinery is manufactured in others than the First Circuit, and installed and used across the entire country. (See Appendix B for specific cases in other Circuits to which petitioner itself was a party and involving shoe machine patents.)

Paragraph 4: It is submitted that the two appellate decisions herein are in perfect accord; but, if they are not, the second decision dominates and there is nothing in the circumstances in the case to suggest any such conflict of decisions between *different* Circuit Courts of Appeals as to bring the case within either the letter or the spirit of Supreme Court Rule 38, 5 (b).

Re Petitioner's Brief.

Petitioner's constant reference to its own contentions below (as though said contentions were actual fact) and its apparently improvident statements as to the findings of the courts below result in such confusion that it does not appear incumbent upon respondents to attempt to answer in particular each of the allegations of the brief.

Conclusion.

Perusal of the second opinion of the Circuit Court of Appeals will suffice to show that all matters of fact and law relevant to the case presented were considered; that the law was correctly applied to the facts found; and that these facts were established chiefly, and almost wholly, by the undisputable evidence furnished by the operation of structures, respectively, shown in the patents in suit and made by respondents. It is also manifest, upon reading the petition and the brief in support thereof, that the writ of certiorari is prayed for solely for the purpose of having this Court review the evidence in an ordinary patent case on the ordinary questions of validity and infringement; that the lower courts found all the elements of the patented combination, or their equivalents, in the defendant's structure; that in deciding the patents were valid and petitioner infringed, the courts below followed established rules of law; and that the case is of importance only to the parties thereto. It is precisely the kind of case which does not warrant the issue of a writ. *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U.S. 387. *Keller* v. *Adams-Campbell Co., Inc.*, 264 U.S. 314. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 416, citing *La Bourgogne*, 210 U.S. 95, 114. *Universal Oil Products Co.*

v. *Globe Oil & Refining Co.*, 322 U.S. 471, where the Court remarked (on p. 473):

> "Where the questions presented by the contested claims of infringement and validity are purely factual, this court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases," citing *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275 (60 U.S.P.Q. 386).

Respectfully,

CHARLES S. GROVER,
Counsel for Respondents.

ROBERTS, CUSHMAN & GROVER,
RICHARD F. WALKER,
Of Counsel.

APPENDIX A.

Brief History of the Kamborian Invention.

For convenience the petitioner, the United Shoe Machinery Corporation, is here referred to as the "United," and the co-respondents Kamborian and the International Shoe Machine Corporation as "Kamborian."

For almost fifty years the petitioner, United, has been supplying the shoe industry with machinery, including lasting machines. At present it maintains a staff of over two hundred employees in its research or experimental department (R. p. 123, XQs. 297, 298; p. 152, XQ. 539). United has taken out a great many patents for lasting machines. However, throughout its entire history its only commercial machines have slavishly followed the old hand-lasting procedure (originally performed by hand with the aid of a pair of pincers) of gripping the margin of the shoe upper at a given point by means of nippers (in the machine, mechanically actuated), exerting updrafting stress at this point to stretch the upper about the last, drawing or wiping the stretched portion of the upper inwardly over the last bottom and fastening it, then opening the nippers and shifting them to another part of the upper, and so continuing intermittently, step by step, until the lasting is completed. It never had a successful lasting machine of the *continuous* type using in combination a work-feeding roll and wipers prior to the accused machine (R. p. 152, XQs. 553-555).

Kamborian was an experienced and skilled shoe-laster familiar with the usual commercial machines built by the United. He conceived the wholly novel idea that opposed, gripping and feeding rolls could be employed for gripping the material of the shoe upper while applying the updrafting stress. Being familiar with the necessities of the last-

ing operation, he would naturally expect to include an appropriate form of wiper, and requisite parts to position a shoe properly in any machine employing such work-gripping rolls. Having no facilities for technically designing or properly building such a machine, he himself put together his first crude model from scrap material. And when completed, behold, it worked! It was the *first* machine to do *continuous* lasting successfully. His machine was far simpler and less complicated than the machines previously available to the shoe manufacturer and in its commercial form greatly speeds up production and reduces costs.

After two years of struggle—plagued by financial difficulties and dilatory machine builders—he finally got his machine into commercial form. In the meantime he had filed his patent application in which he illustrates, in its essentials, his first crude but operative model. Observing that his helically ribbed rolls, when associated with the other parts of his machine, exerted the updrafting stress necessary to lasting, he so described their action in his application. (Demonstration before the District Court proved that his machine actually does exert the necessary updrafting stress.)

Kamborian's essential concept was to substitute (for the usual prior, intermittently acting, opposed nipper jaws) a novel gripping means which, while holding the upper with a firm, positive grip, will uninterruptedly feed the shoe along while the lasting stress is being applied and which, as it seizes a new era, delivers the area which has just been stressed into the field of action of a wiper device of a kind capable of wiping in the material as fast as it is delivered to it by the gripping means. His illustrative embodiment of such a continuously acting gripping device is a pair of opposed, constantly rotating rolls, and his illustrated embodiment of a wiper device was a rapidly recip-

rocating, narrow finger or blade. At the time when he made his application for patent this was the best embodiment known to him.

Kamborian was a pioneer inventor (Judge Sweeney's Opinion, R. I, p. 14, par. 3, where Judge Sweeney said: "The Kamborian machine provided a *continuous,* instead of a step by step, lasting operation. This was the first successful machine of this type on the market. . . . By a combination of two old and well-known devices, Kamborian has achieved that success for which the industry had been searching for a long time. . . . The Kamborian machine produced the first successful technique for *continuous* lasting, . . .").

Kamborian had mapped out a wholly new path in an ancient field. The broad claims of his patent here in issue refer to his opposed rolls broadly as "gripping means." Other claims of his patent specifically refer to the *opposed rolls.*

Although Kamborian was without adequate means for publicizing his new machine, the immediate demand for it in the trade was so great that for a long period he was unable to satisfy the demand.

The United Shoe Machinery Corporation, with its highly organized plant for designing and building shoe machinery and with its corps of more than two hundred men in its research department, and although free to build any one of the lasting machines disclosed in its hundreds of expired and unexpired patents, immediately took steps to appropriate the basic features of the new Kamborian machine. Kamborian put his first commercial machine on the market in February, 1941, and the United had its first machine of the continuous type in experimental operation in a shoe factory in 1943. It is true that the United did not make a Chinese copy of Kamborian's patented machine, but its machine functioned in the same way and by the use

of equivalent means as specifically found by the District Court (Opinion, R. p. 16):

> "Both machines provide for the automatic feed of the work. Both machines provide gripping means which, during the progress of the work, constantly seizes fresh portions of the material of shoe upper, while, at the same time, releasing the portions of just previously seized and stressed, the latter immediately being engaged by wiping means. Both machines have work engaging elements; plaintiffs', two oppositely rotating rolls, defendant's, one rotating roll acting against a polished plate. These work engaging elements exercise on both machines a positive grip, with varying amounts of slippage. In both machines the gripping means operate not only to feed the work forwardly, but also to tension the material of the upper. . . . Both machines provide for a wiper to engage the margin of the upper material immediately after it leaves the gripping means, and lay it down into adhesive contact with the insole."

APPENDIX B.

Cases in Other Circuits.

The following patent cases to which the *United Shoe Machinery Corporation has recently been a party* arose in other Circuits:

United Shoe Machinery Corp. v. *Ferree,* 64 F. (2d) 101; *Second* Circuit. The patent involved related to a clicking machine, used in the shoe industry.

United Shoe Machinery Corp. v. *Gordon,* 59 F. (2d) 903; *Sixth* Circuit. The patent involved concerned a machine for cutting on heel seats, used in the shoe industry.

United Shoe Machinery Corp. v. *Brooklyn Wood Heel Co.*, 77 F. (2d) 263; *Second* Circuit. The patent involved related to a machine for grooving wood heels, used in the shoe industry.

United Shoe Machinery Corp. v. *O'Donnell*, 84 F. (2d) 383; *Sixth* Circuit. The patent involved concerned a folding machine, used in the shoe industry.

United Shoe Machinery Corp. v. *Williams*, 121 F. (2d) 273; *Sixth* Circuit, which concerned two patents, one being a *lasting* machine, and the second a fastener inserting machine, both used in the shoe industry.